

## REMARKS

### Introduction

Claims 1, 3-16, and 20-31 are pending in this application.

Claims 1, 3-5, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser, U.S. Patent No. 6,446,261 (hereinafter "Rosser") in view of Klosterman et al., U.S. Patent No. 5,940,073 (hereinafter "Klosterman"). Claim 6 is rejected under 35 U.S.C. § 103(a) as being obvious from Rosser and Klosterman in further view of Dedrick, U.S. Patent No. 5,724,521 (hereinafter "Dedrick"). Claims 7, 8, and 11-14 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser and Klosterman further in view of Rothmuller, U.S. Patent No. 5,635,989 (hereinafter "Rothmuller"). Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser, Klosterman, and Rothmuller further in view of Young et al., U.S. Patent No. 5,353,121 (hereinafter "Young"). Claims 20, 21, 24, and 25 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Dedrick and Klosterman. Claims 22, 23, 26, and 27 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser and Dedrick further in view of O'Flaherty et al., U.S. Patent No. 6,253,203 (hereinafter "O'Flaherty"). Claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as being obvious over Rosser and Klosterman further in view of Marsh et al., U.S. Patent No. 5,848,397 (hereinafter "Marsh"). Claims 30 and 31 are rejected under 35 U.S.C. § 103(a) as being obvious over Rosser, Dedrick, and Klosterman further in view of Marsh.

Applicant has amended claims 1, 7, 11-15, 20, 23 and 24 to more particularly define the invention. No new

matter has been added and the amendments are fully supported by the originally filed specification.

Reconsideration of this application in light of the amendments and the following remarks is hereby respectfully requested.

Applicant's Reply to the Rejection of  
Claims 1-16, 28 and 29 Under 35 U.S.C. § 103(a)

Independent claims 1 and 15 are rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Klosterman. The Examiner's rejection is respectfully traversed.

Applicant's amended independent claims 1 and 15 are directed toward a method and system for targeting advertisements to television viewers that have a television receiver and a television screen that displays an electronic program guide (EPG) from EPG data stored in an EPG data base. Use of the EPG is monitored and a viewer profile is developed based on viewer usage of the EPG using the EPG data from the EPG data base. A plurality of advertisements are received by the receiver and fewer than all of those advertisements are stored on the receiver depending on the viewer profile. One or more of the stored advertisements are displayed on the television screen in the EPG.

In other words, applicant's amended independent claims 1 and 15 are, generally speaking, directed toward a system for selectively storing advertisements to be displayed in an EPG based on monitoring the viewer's usage of the EPG. For example, usage of the EPG, such as which programs are selected for scheduling to record, to watch, or to display more details, or which programs are highlighted with the cursor and how often is monitored to develop the user profile. Only those advertisements that match the user

profile are stored on the receiver and are displayed to the viewer within the EPG.

Rosser refers to a set-top device configured to use narrow casting techniques to "perform seamless insertion of still, animated, and live video indicia into the video stream in a way that can make the inserted indicia appear to the end user as if it were part of the original scene." Rosser, column 7, lines 41-45. A user's viewing habits are monitored and a viewer profile is derived from the monitored usage. Advertisers may then target specific advertisements or indicia to be inserted into the broadcast video of viewers based on their viewer profiles.

The Examiner contends that Rosser shows all of the elements of applicant's independent claims 1 and 15, except displaying an EPG on the television screen and displaying the advertisements within the EPG. To address these deficiencies in Rosser, the Examiner contends that it would be obvious to modify Rosser to include the EPG disclosed in Klosterman.

I. THE CITED REFERENCES DO NOT SHOW OR SUGGEST ALL OF THE ELEMENTS OF APPLICANT'S CLAIMS

Applicant respectfully submits that nothing in either Rosser or Klosterman shows or suggests all of the elements of applicant's amended independent claims 1 and 15. In particular, these references do not show or suggest i) selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile or ii) monitoring a viewer's use of an EPG and developing a viewer profile based the monitored usage of the EPG using EPG data from the EPG data base, as specified by applicant's independent claims 1 and 15.

The Examiner contends that Rosser shows selectively storing fewer than all of the received advertisements,

however, no basis for this contention can be found in Rosser. While Rosser refers to the selective display of advertising based on a viewer usage profile, nothing in Rosser shows or suggests selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile.

In support of this contention, the Examiner cites two portions of Rosser - neither of these portions of Rosser show or suggest this feature of applicant's claims. The first cited portion of Rosser states:

In particular, by comparing the viewer usage profile keys 120 with local viewer usage profile 50, different insertions 58 and 60 may be made on different end users video viewing devices 56. The different insertions may be permanently stored locally in memory device 55, or downloaded, there during or prior to transmission of the live video transmission in which they are inserted. Rosser, column 7, lines 51-58.

Thus, Rosser shows that irrespective of the insertion made on the different end user viewing devices, both of the two "different insertions 58 and 60" are stored at the receiver. The second cited portion of Rosser states:

This alternate video feed would typically be relaying a number of different advertisements with a requested viewer usage profile or range of profiles suitably associated, attached to or encoded in, each particular advertising sequence. The contents of the alternative feed may be stored in video and audio storage unit 152. At the appropriate time and place for advertising insertion . . . an appropriate advertisement [is placed] on the end user's viewing device 106. Rosser, column 13, lines 19-33.

Here too, Rosser shows that the alternate video feed, which contains multiple advertisements, is stored at the receiver and that an appropriate advertisement is selected from the multiple advertisements of the alternate video feed.

Therefore, Rosser does not show or suggest selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile, as specified by applicant's amended independent claims 1 and 15. Disclosure also cannot be found in Klosterman for this feature of applicant's claims.

In fact, applicant's claimed invention represents an improvement over Rosser. By selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile, memory space in the receiver may be conserved. In contrast, in Rosser, more memory is required because all of the alternative advertisements are stored.

Furthermore, Rosser and Klosterman do not to show or suggest all of the elements of applicant's amended independent claims 1 and 15 for at least the additional reason that, neither reference shows monitoring a viewers use of an EPG and developing a viewer profile based the monitored usage of the EPG using EPG data from the EPG data base.

Accordingly, whether taken alone or in combination, Rosser and Klosterman fail to show or suggest i) selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile or ii) monitoring a viewer's use of an EPG and developing a viewer profile based the monitored usage of the EPG using EPG data from the EPG data base, as specified by applicant's independent claims 1 and 15.

## II. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION TO COMBINE THE REFERENCES

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found

either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak , 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside , 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Rosser with Klosterman, the Examiner states that:

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser to include displaying an EPG on the television screen, as taught by Klosterman, for the benefit of displaying an electronic program guide that provides users with means to locate and select programming of interest. Office Action, p. 6.

Applicant respectfully submits that this is not sufficient motivation to combine Rosser and Klosterman. Rather, the Examiner has merely listed an alleged benefit of electronic program guides instead of pointing to an objective teaching in either Rosser or Klosterman that would lead one of ordinary skill in the art to combine these references in the manner suggested by the Examiner. Namely, the Examiner has indicated that there is a benefit to providing program

listings within an EPG, but not why one of ordinary skill in the art would be motivated to modify Rosser to display promotional information within an EPG when Rosser already refers to another suitable technique for displaying promotional information, i.e., narrow casting. These two divergent advertising techniques cannot be combined in the manner suggested by the Examiner without an objective teaching in either Rosser or Klosterman that would lead one of ordinary skill in the art to combine these references. Accordingly, the Examiner has not provided sufficient motivation to combine Rosser or Klosterman.

### III. THE EXAMINER HAS EMPLOYED HINDSIGHT RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for targeting advertisements to television viewers within an EPG, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Rosser and Klosterman. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

#### IV. CONCLUSION

Accordingly, applicant respectfully requests that the rejection of amended independent claims 1 and 15 over Rosser in view of Klosterman under 35 U.S.C. § 103(a) be withdrawn.

Applicant also respectfully requests that claims 3-14, 16, 28, and 29 be allowed, at least because they depend from allowable independent claims 1 and 15.

#### Applicant's Reply to the Rejection of Claims 20-27, 30, and 31 Under 35 U.S.C. § 103(a)

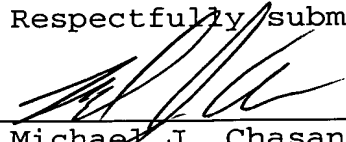
Applicant has amended independent claims 20 and 24 to include all of the features of applicant's amended independent claims 1 and 15. For at least this reason, applicant respectfully requests that the rejection of applicant's amended independent claims 20 and 24 also be withdrawn.

Applicant also respectfully requests that claims 21-23, 25-27, 30, and 31 be allowed, at least because they depend from allowable independent claims 20 and 24.

#### Conclusion

The foregoing demonstrates that this application is in condition for allowance. Accordingly, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Michael J. Chasan  
Registration No. 54,026  
Agent for Applicant

Fish & Neave IP Group  
Ropes & Gray LLP  
Customer No. 1473  
1251 Avenue of the Americas  
New York, New York 10020-1105  
(212) 596-9000